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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91193959
Party	Defendant Torrevento s.r.l.
Correspondence Address	Torrevento s.r.l. Strada Provinciale 234, km. 10 I-70033 Corato (BA), ITALY
Submission	Other Motions/Papers
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Signature	/Francesco LIANTONIO/
Date	04/08/2010
Attachments	Reply to opposition USA.pdf (4 pages)(5462958 bytes) Annex A.pdf (1 page)(45872 bytes) ANNEX B.pdf (1 page)(830708 bytes) Annex C.pdf (2 pages)(488871 bytes)



TORREVENTO

Corato, April 08, 2010

Sent by online and mail

USPTO
TRADEMARK TRIAL AND APPEAL BOARD
P.O. Box 1451
Madison Buildings
600 Dulany Street
Alexandria, VA 22313

Number opposition: 91193959

Name of the applicant/holder: Torrevento s.r.l.

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Mark: TORREVENTO and device, US serial number: 79069543

RE: Observations in reply to the notice of opposition 91193959

Dear Sirs,

We are writing in respect to the above opposition against the US figurative trademark "TORREVENTO" serial number: 79069543 and its consequent demand of refusal in class 33 (of Nice classification), priority and likelihood of confusion as Trademark Act section 2(d).

The pertinent territories of the opposition are United States of America.

Referring to the above mentioned act of opposition, we are communicating you as follows.

Our company believes that there isn't exist likelihood of confusion on the part of the public, in pertinent territory, in fact, our trademark is very different compared to the opponent's trademarks respect to visually, phonetically and conceptually impression and in comparison of the goods.

A. LIKELIHOOD OF CONFUSION

Because the marks in competition are Europeans might be useful to cite how administrative and ordinary courts have expressed in similar cases in Europe.

According to Article 8(1) CTMR, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered if, because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public in territory where the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark (*see C-251/95, Sabel BVv. Puma AG, Rudolf Dassler Sport, GU UAMI n. 1/1998, par.22 e ss*).

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Istituto per la Certificazione
Etica e Ambientale



In fact, to the case-law of Court of Justice, in determining the existence of likelihood of confusion, trademarks have to be compared by marking and overall assessment of the visual, phonetic and conceptual similarities between the marks (...) (*see Judgment of the Court of Justice; Case C. 251/95 Sabél BV v Puma AG, Rudolf Dasler Sport (1997), OJ OHIM 1/98, p. 91 paragraph 23*).

In addition, for the purposes of this overview, it is assumed that the consumer through the product category under consideration is a consumer who is informed and reasonably observant and circumspect (*see, to that effect, 16 July 1998 Gut Springenheide and Tusky, C-210/96, Rec. p.I-c -4657, paragraph 31*).

However, it must take into account the fact that the average consumer has rarely the possibility directly to compare the marks, but he must rely stored in memory on imperfect image.

It should also take into consideration the fact that the level of care of the average consumer may vary depending on the product or services considered (*Ruling of the Court, C-342/97 Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV [1999] DO OHIM 12/99, p. 1568, paragraph 26*).

1. Comparison of signs

As stated by the Court of Justice of the European Communities, "*regarding to the graphical similarity, phonetical or conceptual similarity of the conflicting marks, this global assessment has to be based on the impression created by the marks, bearing in mind, in particular, their distinctive and dominant elements*" (Case C-251/95 *Sabel BV v Puma AG, Rudolf Dassler Sport [1997] DO OHIM 1/98, p.91, paragraph 22 and seq.*).

The signs which have to be compared are:

For the opponent: TORRES 20, TORRES 10, TORRES 5, MIGUEL TORRES, TORRES

Early registration marks USPTO Applications

For the applicant TORREVENTO SRL



1.1. Visual differences of the signs:

As above evident, the earlier denominative marks consist of the word "TORRES". The opposition is directed against the figurative USPTO trademark "Torrevento" and device.

The first signs are generally denominative trademarks composed by six letters only, sometime with numbers, while the second one is composed by ten letters.

Farther, the second sign is a figurative trademark, in fact: ***the trademark consists of the word "Torrevento" written in capital and fancy characters, on the top of that there is a figure composed by three octagons horizontally arranged intersecting, where those lateral are smaller than central one.***

Even if we can consider that all marks have got the common prefix "TORRE", the trademarks in comparison differ a lot in length, the presence of the ".S" at the end of the earlier marks and the suffix "..VENTO" in the CTM application, gives all marks a different structure, length and pace (*see in similar case opposition UAMI decision n. 686487/2006, TORRES/TORREGAZATE*).

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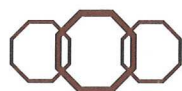
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TORREVENTO

1.2 Phonetical differences of the signs:

From a phonetic point of view the earlier marks have got at least six letters and are structured in two syllables (TO//RRES) or (TO//RRES//5) or (Mi//guel TO//RRES), while the USPTO application consists of ten letters and is structured in four syllables (TO//RRE//VEN//TO).

The presence of personalized suffix, well differential *"..VENTO"* establishes a clear phonological distinction with the early marks (*see in similar case opposition decision n. 686487/2006, TORRES/TORREGAZATE*).

1.3. Conceptual differences of the signs:

From a conceptual point of view it should be noted that in this territory where the earlier marks are protected and whose consumers don't know the meaning of the word "TORRE".

The word "TORREVENTO" is an indivisible logical unit and a typical Italian fantasy name, in fact it ends with the vowel "o" unlike opponent marks Torres and Miguel Torres, which are names with Spanish meaning, "TORRES" is a common surname in Spain and Portugal and probably in US (*see you "lexisnexis surname database" and "USPTO data base"*, existing as so also in Italy (*see in similar case opposition decision n. 686487/2006, TORRES/TORREGAZATE*). The prefix Torre is also a common name used in Trademark in class 33 (*see you annex A*).

If Torres is the surname of person the word Torrevento takes origin from *"Torre del vento"* is the name of Apulia countryside where there is a tower of Federico II, Castel del Monte, and headquarters of the company Torrevento (*see you [http://en.wikipedia.org/wiki/Castel_del_Monte_\(Apulia\)](http://en.wikipedia.org/wiki/Castel_del_Monte_(Apulia))*, (*see you annex B*).

In US, it does not given any specific meaning to the word prefix "TORRE" , as so the suffix *"-VENTO"*, so it must be concluded that the consumers of those US States will **perceive the mark "TORREVENTO" as a logical unit**, with no reason to distinguish the presence of different elements (*see in similar case opposition decision n. 686487/2006, TORRES/TORREGAZATE*).

In conceptual difference we believe that figurative elements based of three octagons on the top of Torrevento, has got an important function.

Consequently, these assumptions there is no conceptual similarity of signs.

2. Final Consideration and claims.

The comparison of the signs (phonetically, visually and conceptually) shows that the marks in matter are very different.

Furthermore in the search of USPTO office action of examiner, as not cited any similarity between Torrevento and other trademarks like *"torres"*. So it means that probably, there was not likelihood of confusion.

The common knowledge that the markets of above mentioned goods (in class 33); the appearance of the goods, generally, plays a very important role in respect of the public's perception. The reference consumer, i.e. brandy, wine, etc. would like always to see goods and packaging before or during the purchase. It gives special attention to the visual aspect of distinctive signs which is normally represented on the goods or on packaging. The consumer will be brought to set more attention during the choice of the product seeking, on label, other distinctive characters, then he will be brought to read the whole writing and he won't read only a part of label.

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We would like recall that the mark of Torrevento is a complex figurative mark as appears. Furthermore we would like to mention also that Miguel Torres, for all opponent marks, has always submitted labels as specimen in Declaration of use only (see you annex C).

3. Family marks.

Besides, regarding the matter of "family marks", in similar case, the European Court of Justice has required continuous use of early marks during the entire period under review. It should be noted that, as shown by Court, *a mark is the subject of serious use when it performs its essential function, which is guarantee the identity of origin of goods or services for which it is registered, in order to create or maintain for them an continuity, with the exception of uses symbolic, which are intended only to preserve the rights conferred by registration. In verifying the reliability of the use of the mark must be taken into consideration all the facts and circumstances which may prove the effectiveness of its commercial use, in particular the amplitude and frequency use of the mark (see C-234/06 P, pg.8 par.72, case BRIDGE, OLD BRIDGE, THE BRIDGE/Bainbridge; Opposition decision n. 686487/2006, TORRES/TORREGAZATE).*

Additionally, respecting to the possible existence of a family of marks based on the common use of the term "TORRE", the opponent has neither proved that the public are duly recognized this element as indicator of the same company, either proved simple use of marks, in fact it has always tried to use with declaration and labels (see you annex C).

However, even when the existence of family of marks that have been demonstrate, it does not affect the assessment of the similarity between the signs since the structure presented by opponent marks is based on the word "TORRES" (and not the singular form) as when combining with number, verbal or other additional elements.

We must not forget at one hand "TORRES" is **not essentially** identical to "TORRE" and secondly, the element "torre" is not an individual element (...) (in similar case, see you OAMI Opposition decision n. 686487/2006 TORRES/TORREGAZATE, pg.13, par.3).

In fact, the USPTO Torrevento is also, a figurative trademark



(...) consisting of the word "Torrevento" written in capital and fancy characters, on the top of that there is a figure composed by three octagons horizontally arranged intersecting, where those lateral are smaller than central one.

For the above reasons the applicant claims that the USPTO-TRADEMARK TRIAL AND APPEAL BOARD:

- a) Rejected the opposition;
- b) Order Miguel Torres S.a. to pay the costs;
- c) Task to the opponent proof of genuine use of the opponent marks.

Annex A: list marks Torre....as proof of low degree of distinctivity

Annex B: map of the area Torre dei Venti where is established Torrevento Srl

Annex C: last specimen declaration of use of Torres.

Signed for Torrevento S.r.l.
Francesco LIANTONIO
Sole director

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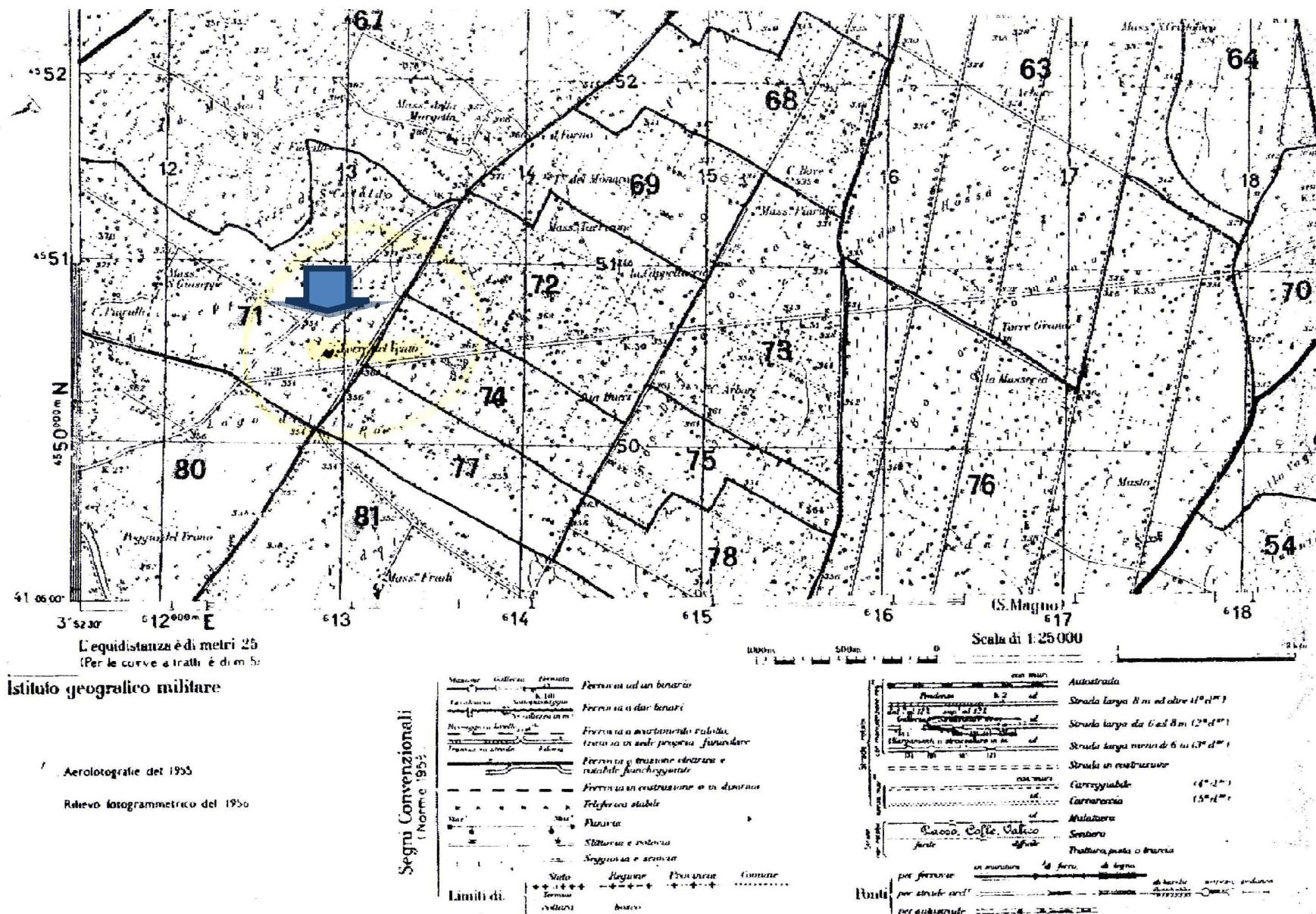
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ANNEX A.

trademark	Serial number	Filing date	Registration number	International class	First use date	First use in commercial date
TORRE ALBENIZ <i>(words only)</i>	79078667	2009-06-26		33 (Wines)		
TORREORIA <i>(and a little design)</i>	79064897	2008-08-14	3737150	33(Wines, sparkling cava wines)		
TORREVILLA	79034428	2006-11-27	3352718	33(Wines, sparkling wines; wine based aperitifs with a distilled alcoholic liquor base; liqueurs)		
TORRE DI GIANO	79019037	2005-10-21	3202379	33(wine, red wine, white wine, sparkling wine, fortified wine, aperitif wine, sweet wine, grappa).		
TG TORRE GALATEA <i>(and a design)</i>	78160308	2002-09-03	2836365	33(alcoholic beverages, namely, wine brandy and sparkling wine)		
TORREMAYOR	78201886	2003-01-10	3473576	WINE, namely, Spanish white and red wine from ribera del guardiana		
Opp.TORRES 20 <i>(design mark)</i>	75551944	1998-09-11	2267400	33 (BRANDY)	1996-00-00	1998-03-00
Opp.TORRES 5 <i>(design mark)</i>	76514638	2003-05-14	2859655	33 (BRANDY)	2000-05-29	2000-05-29
Opp.TORRES 10 <i>(design mark)</i>		1984-07-18	1358370	33 (BRANDY)	1993/00/00	1997-12-31
Opp.MIGUEL TORRES		1984.07-18	1358370	33 (BRANDY)	1980-01-00	1980-01-00
TORRES		1969-02-07	897048	33 (BRANDY,WINES)	1962-02-00 (wines) 1953-00-00(brandy)	1964-04-10 (wines) 1953-00-00 (brandy)

ANNEX B.



Declaration**Section 8: Declaration of Use in Commerce**

Unless the owner has specifically claimed excusable non-use, the mark is in use in commerce on or in connection with the goods and/or services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.

Section 9: Application for Renewal

The registrant requests that the registration be renewed for the goods and/or services identified above.

The undersigned being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

Signature Section

Signature: _____

Date: June 18, 2009

Signatory's Name: Ms. Rosa Arhan Piñol

Signatory's Position: Chief Administrative Officer

NOTE TO APPLICANT: When filed as part of the electronic form (i.e., scanned and attached as an image file), the signature page **must** include both the signature information **and** the boilerplate declaration language. Do **not** include the entire application, but do ensure that the boilerplate declaration language actually appears; *a signature by itself will not be acceptable*. If, due to browser limitations, the boilerplate declaration language appears on a previous page when printed, you must "merge" the declaration and signature block onto a single page prior to signing, so that the *one complete page* can be scanned to create an acceptable image file. It is recommended that you copy-and-paste the entire text form into another document, manipulate the spacing there to move the declaration and signature section to a separate page, and then print this new version of the text form to send to the signatory.

